

REMARKS

Claims 1 – 26 remain in the application and stand rejected. Claims 16 and 20 are amended herein. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any additional fees that may be required for this paper or credit any overpayment to Deposit Account No. No. 50-3818.

The MPEP provides in pertinent part “the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.” MPEP §2164.04 (emphasis original).

The specification is objected to for not providing antecedent basis for the claims reciting a “computer program product,” a “computer usable medium” and a “computer-readable medium,” as recited in claims 16 – 26.

“The meaning of every term used in any of the claims should be **apparent** from the descriptive portion of the specification with clear disclosure as to its import;” MPEP §608.01(o) (emphasis added). Moreover,

While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is **departed from by amendment** of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. *Id* (emphasis added). “The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP §2163.02.

Thus, there is no antecedent basis requirement for the claims, as filed, set forth in 35 USC or 37 CFR or otherwise explained in the MPEP. Instead, the meaning must be apparent. *Supra*. Applicant asserts that the meaning of the claims, as filed, is apparent from the specification, which describes: “[c]entral storage (e.g., on a server 114) stores identity context information for

workgroup users, for example, employee calendar data, contact data or any data that might be found in a personal information manager (PIM) application” (page 4, lines 14 – 16); and the “flow diagram 140 for providing identity context reminders ... [wherein] Users provide location and presence data in step 142, which is stored in the central data repository in step 144” (page 6, lines 15 – 18). Therefore, applicant believes that the application, as filed, sufficiently provides an apparent meaning for the recitations of the claims, as filed. Be that as it may, the specification is amended herein to provide additional support. MPEP §§608.01(i) and 608.04 (“In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it.”). No new matter is added. Entry of the amendment, reconsideration and withdrawal of the objection to the specification is respectfully requested.

Claims 16 – 23 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, i.e. “as a program per se, which is non-statutory.” Office action page 3. The Office action further notes that because claims 24 – 26 recite that instructions are stored on the computer-readable medium, they were not rejected. Accordingly, claims 16 and 20 are amended to recite “a computer usable medium having computer readable program code stored thereon,” and, therefore, also are believed to be directed to statutory subject matter. Reconsideration and withdrawal of the rejection of claims 16 – 23 under 35 U.S.C. §101 is respectfully requested.

Claims 1 – 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,484,033 to Murray in combination with U.S. Patent No. 7,039,420 to Koskinen et al. The rejection is respectfully traversed.

In responding to applicant’s remarks in the previously filed amendment after final, the Office action asserts that Koskinen et al. claim 6 teaches that “for each of said ones said identity context reminder service monitors multiple associated devices of said plurality of communications devices for inconsistencies in one or more,” as recited in claim 1, for example. Office action, # 4, bridging paragraph pages 2 – 3.

Koskinen et al. is directed “to a method for activating actions.” Abstract, lines 1 – 2. “In an advantageous embodiment of the invention, the user can enter data about location-specific actions such as reminders which can be supplemented with time data. The action can thus be restricted to apply to a given time (time range) only.” Col. 3, lines 5 – 9. Thus, Koskinen et al. provides a number of selectable conditions precedent for taking action. So, Koskinen et al. claim 6 recites “**if the conditions** for activating the action **are met** in one portable device from said set of portable devices, the action is activated.” Col. 14, lines 41 – 43 (emphasis added). Thus, Koskinen et al. teaches (and claims) taking action in response to a consistency in what is expected, i.e., complying with the conditions for activating. However, “if the conditions for activating the action **are not met** within said validity time, the action data is deleted **after the expiry** of said validity time.” *Id.*, claim 5, col. 14, lines 45 – 48 (emphasis added); claim 14, col. 15, lines 31 – 33; *and see*, col. 4, lines 6 – 10.

As previously noted, the Murray application server 76 monitors stored event information and only the occurrence of a *scheduled* upcoming event (i.e., in anticipation of the event or the actual occurrence of the event) causes action by the Murray application server 76. Col. 10, lines 38 – 46 (“in Step 166, the event information 120 and current location 122 of the wireless communication device 32 are compared to the event criteria parameters 129. This comparison is done by the server event management application 82. When the event information 120 and the current location 122 do not match the event criteria parameters 129 in Step 166, the process ends.”). Until after a scheduled time for an event passes, the application server 76 takes no action. *Id.*, lines 59 – 65 (“Additionally, an update message 36 can be sent to the wireless communication device 32 to indicate to the device user 68, via the alert circuit 102 and/or display 104, that a match **has occurred** in Step 166, and that the device user 68 is possibly in a location too far from the upcoming event to allow the device user 68 to attend.”). However, between events, the device user 68 can be using other devices, traveling to distant locations, even out of the country, unnoticed and unprodded by the Murray application server 76. As long as the device user 68 is in the correct location when the event occurs, Murray does not send an update message, “the process proceeds to Step 168.” *Id.*, line 46. *See also*, col. 11, lines 1 – 43.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP 2143.01 VI (citations omitted). A straightforward combination of Murray with Koskinen et al. still results in action upon meeting specific conditions, the occurrence of a *scheduled* upcoming event. If that *scheduled* upcoming event fails to occur, “the action data is deleted **after the expiry** of said validity time.” Koskinen et al., *supra*. Therefore, a straightforward combination of Murray with Koskinen et al. does not result in, or suggest, the present invention as recited in claims 1, 12, 16, 20 or 24.

Moreover, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”). Therefore, Murray fails to teach or suggest the present invention as recited by claims 2 – 11, 13 – 15, 17 – 19, 21 – 23, 25 and 26 which depend from claims 1, 12, 16, 20 and 24. Reconsideration and withdrawal of the final rejection of claims 1 – 26 under 35 U.S.C. §103(a) is respectfully requested.

The applicant thanks the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests that the Examiner reconsider and withdraw the objection to the specification, reconsider and withdraw the rejection of claims 1 – 26 under 35 U.S.C. §103(a) and allow the application to issue.

The applicant notes that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added.) The applicant believes that the written description of the present application

is quite different than and not suggest by any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

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Respectfully submitted,

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